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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,879	11/06/2001	Joseph Nardone	003636.0126	4505
7590	06/05/2009		EXAMINER	
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		ART UNIT	PAPER NUMBER	
		2176		
			MAIL DATE	DELIVERY MODE
			06/05/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH NARDONE, JEFFREY PHELPS,
and MARK WALLACE

Appeal 2008-3437
Application 09/985,879¹
Technology Center 2100

Decided:² June 5, 2009

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed November 6, 2001. Appellants claim the benefit under 35 U.S.C. § 119 of provisional applications 60/245,677, 60/245,678, 60/245,713, all filed November 6, 2000. The real party in interest is Telecommunication Systems, Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 through 57 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method and apparatus for creating conduits for synchronizing the data in one device, such as a personal digital assistant (PDA) with the data in another device, such as an enterprise server. Conduits are the specialized programs that arrange the transition of the data as it goes from one device to another, for example conduits arrange for the "first name – last name" combined field on a PDA or a cell phone to wind up, after synchronizing, in the proper "first name" and "last name" separate fields in a server, and vice versa. (cite?) In the words of the Appellants:

A configurable conduit generator module is utilized to generate customizable conduits. The configurable conduit may be configured to provide the synchronization rules between client databases and corresponding enterprise databases. The configurable conduit generator module may be configured to provide a point-and-click environment to create the configurable conduit. In particular, a graphical user interface (GUI) may be presented to the user to select the client database and to select the enterprise database. Another GUI may be presented to provide the mapping of the fields (or columns) from the client database to the enterprise database. The direction of the synchronization may be also be specified. Once the mapping of the fields is created, the mapping file is saved for execution by the configurable conduit during a synchronization event.

(Spec. 31, Abstract).

Claims 1 and 12 are exemplary:

1. A method of creating conduits for synchronizations, comprising:
 - generating a first graphical user interface;
 - selecting a first database and a second database on said first graphical user interface;
 - mapping at least one field of said first database to a corresponding field of said second database in a map file;
 - programming a conduit with said map file; and
 - executing said conduit with said map file in response to a synchronization request, wherein said conduit provides synchronization rules from said map file for said first database and said second database.

12. A method of synchronizing databases, comprising:
 - configuring a conduit with a graphical user interface to synchronize a first database and a second database;
 - initiating a synchronization request; and
 - synchronizing said first database and said second database according to said conduit in response to said synchronization request.

PRIOR ART

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hawkins	6,000,000	Dec. 7, 1999
		(filed May 4, 1998)
Robertson	2001/0047441 A1	Nov. 29, 2001
		(filed Feb. 22, 2001)

Roderick Smith, *The Multi-Boot Configuration Handbook* (Que Publishing, 2000) (hereinafter ‘Smith’).

REJECTION

The Examiner rejected the claims as follows:

R1: Claims 1 to 57 stand rejected under 35 U.S.C. § 103(a) for being unpatentable over the combination of Hawkins, Robertson and Smith.

Groups of Claims:

Claims were argued together and will be discussed together. *See* 37 C.F.R. § 41.37 (c) (vii). *See also In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002).

Appellants contend that the claimed subject matter is not rendered obvious by the references Hawkins, Robertson or Smith, for failure of the references to teach key claimed limitations. The Examiner contends that each of the claims is properly rejected.

We affirm the rejection.

ISSUE

The threshold issue before us is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). Particularly, the issue turns on whether the combination of Hawkins, Robertson and Smith teaches the claimed method of creating conduits.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method for creating conduits used for synchronizing data between two devices, such as a PDA and an enterprise server. (Spec. 2, l. 10). This is performed using a configurable conduit generator module, embodied in a graphical user interface (GUI), which configures a conduit based on the mapping of fields of a database on the PDA with similar fields on the server. (Spec. 6, l. 19 to 7, l. 7). Once the conduit is properly configured for the two devices, they may be synchronized with the proper data from a database on one device being placed in the proper fields in the database of the other device. (Spec. 8, l. 16-22).
2. The Hawkins patent teaches synchronizing a PDA (e.g. Palm Pilot) with a computer, popularly called “HotSyncing”. (Col. 1, l. 48). The software used for this process includes the synchronization program itself, a sync manager library, and various conduit libraries. (Col. 4, l. 49). The sync manager library oversees the synchronization process using individual conduit libraries to perform the synchronization of each database. (Col. 5,

1. 38). Each conduit library is individually written to suit a particular database residing on the handheld computer system. (Col. 7, 1. 7).

3. The Robertson Patent Application Publication teaches a system for transferring data from a USB format (common on laptops) to various other data formats such as Firewire, Ethernet, etc. (Abstract) common on many handheld devices, including Palm Pilots or a Newton. (¶ [0049]). Knowledge of the different devices is embodied in device drivers. “Conduit” in this document means “the data interface between a plurality of user peripheral devices . . . and a processing device . . . which in turn is coupled to external data nodes . . . through a communications network . . . (e.g. the Internet).” (¶ [0028]). The various device drivers configure the conduit for their individual devices. (¶ [0050]). A user interface is shown to teach the selection of devices to be connected by the user. (Fig. 7).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v.*

Teleflex, Inc., 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

“Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and . . . a person of ordinary skill [often] will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420.

“[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

However, although elements must be arranged as required by the claim, “this is not an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.

SuperGuide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 875 (Fed. Cir. 2004) (citation omitted).

Shortly after the creation of this court, Judge Rich wrote that “[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.” *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). On numerous occasions since then, we have reaffirmed that point

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a *prima facie* case for the rejections of Appellants' claims under 35 U.S.C. § 103(a). The *prima facie* case is presented on pages 3 to 22 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection of claims 1 to 57 under 35 U.S.C. § 103(a) [R1]

Appellants contend that the Examiner erred in rejecting claims 1 through 57 because none of the references teaches how the conduits are created. (App. Br. 5, middle, 6, bottom, 7, middle, 8, top). Appellants contend that Hawkins teaches the use of conduit programs, but the conduit programs are stored in a conduit library and are only used, not created or configured. (*id.*).

Understanding of the rejection starts with a proper interpretation of the claim language. The analysis begins with an interpretation of the claims. "Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

In the instant claims, a key limitation is "programming a conduit with said map file;" (claim 1) or "configuring a conduit with a graphical user

interface” (claim 12). Within these claims the term “conduit” becomes a central issue. We must, thus, explore the meaning of a “conduit.”

In the references before us, we see that “conduit” can partake a number of meanings in this art. In the Hawkins patent, the sync manager library #410 uses individual conduit libraries to perform the synchronization of the databases. (Col. 5, l. 35). In the Robertson patent application publication, the conduit #10 is configured by the special knowledge contained in individual device drivers from the processing devices #14. (¶ [0050]). Though claims are interpreted in the light of the specification, we are advised by our guiding court that “claims must be interpreted as broadly as their terms reasonably allow.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Thus, during prosecution at the USPTO, while claims are still capable of accepting clarifying amendments, the claim terms may be read broadly.

In the instant claims, the only limitations on the term “conduit” in the claims comes from claim 1’s ultimate clause, “wherein said conduit provides synchronization rules from said map file for said first database and said second database.” This limitation is consistent with the listing of responsibilities of a conduit in the Specification. (Spec. 2, bottom, *ff*). With no further limitation of the term in the claims, and in view of the accepted broader interpretation of “conduit” in other related art (*see* Robertson; FF 3), the Examiner has broadly but fairly interpreted “conduit” to include the entire structure that forms the communications link between the client PDA and the host server or computer. When read in this light, we see, for example in Hawkins’ Figure 7, that the combination of the Sync Manager

Library and Conduit Library A is programmed with the files from databases during a synchronization (claim 1). The claimed term “conduit” is read on the combination of both libraries. In a similar light, a conduit is configured (claim 12) in Robertson, Fig. 1, using choices garnered from a selection on a graphical user interface (GUI), Fig. 7. Again, the term “conduit” is read on the entire data converting device, labeled #10, and called “conduit” in the Robertson application.

Appellants argue that the references fail to teach “HOW a conduit is CREATED” (App. Br. 8, ll. 3-4) (bolding and underlining omitted). This argument is not persuasive, as the actual steps in representative claims 1 and 12 both require only that a conduit be “programmed” or “configured,” which is done in both of the references, as explained in the paragraph just above. However the programming of the conduit does result in a fully configured conduit, which in a sense “creates” one.

Appellants further argue that the Examiner has failed to show motivation to combine the Hawkins and Robertson references. (App. Br. 8, bottom). As both references address the same problem (connections of disparate electronic devices) and are from the same field of endeavor, they are properly combined. (*See KSR Int'l Co. v. Teleflex, Inc.*, cited above).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 through 57 under 35 U.S.C. § 103 for being obvious over Hawkins, Robertson and Smith.

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DECISION

We affirm the Examiner's rejection of claims 1 through 57.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc

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